

REMARKS

Claims 1-59 are pending. By this Amendment, claims 1-4, 5, 24, 41-45, 51, 55 and 58 are amended. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

Applicants thank Examiner Brown for the courtesies extended to Applicants' representative during the November 29, 2005 personal interview. The substance of the interview is incorporated in the following remarks.

The Office Action indicates that it is not made final because the Arnold reference, used in the previous Office Action, is not prior art. Applicants note that the Arnold reference (U.S. Patent No. 6,320,094) was filed before the filing date of this application. The Arnold reference was, at the time of the present invention, assigned to the same assignee to which the present application is assigned.

I. Formal Matters

A. As noted in the Remarks of the June 29, 2005 Amendment, the election requirement is improper. The Patent Office has not responded to any of the points raised by Applicants relating to the impropriety of the election requirement. Applicants maintain that the requirement is improper for the reasons set forth previously, and respectfully request that the election requirement be withdrawn and that all claims be examined.

B. The Office Action objects to dependent claim 58, asserting that this claim fails to further limit the subject matter of a previous claim. Applicants respectfully disagree, because, whereas former claim 24 required that the eye patch fit entirely within a human eye socket in a lateral dimension and/or in a vertical dimension, former claim 58 required that the sheet member fit entirely inside the eye socket in both the lateral dimension and the vertical dimension. Therefore, for example, an eye patch with a sheet member fitting within a human

eye socket in a lateral dimension, but not in a vertical dimension, would be covered by former claim 24, but not by former claim 58.

Unrelated to this objection, claim 24 has been amended to broaden the scope by reciting "at least one dimension" instead of "a lateral dimension and/or in a vertical dimension." This change appears to render moot the objection to claim 58.

Accordingly, withdrawal of the rejection is respectfully requested.

II. The Claims Define Patentable Subject Matter

A. The Office Action rejects claims 24-25, 34, 40 and 58-59 under 35 U.S.C. §103(a) over U.S. Patent No. 4,969,472 to Langley et al. ("Langley") in view of U.S. Patent No. 2,527,947 to Loos; and rejects claims 26-33, 35-39, 45 and 50 under 35 U.S.C. §103(a) over Langley in view of Loos and further in view of U.S. Patent No. 4,867,146 to Krupnick et al. ("Krupnick") and U.S. Patent No. 5,469,864 to Rosenblatt. These rejections are respectfully traversed.

The Office Action acknowledges that Langley does not disclose a sheet member being sized to fit entirely within a human eye socket in any dimension, but asserts that Loos discloses such a feature. The Office Action further asserts that it would have been obvious to size the Langley patch with the dimensions taught by Loos, the motivation being "to prevent the pad from being dislodged from the eye socket." Applicants respectfully disagree.

First, the alleged motivation to combine is improper, at least because the Langley eye patch is already prevented from being dislodged because it is held in place by tape or a headband.

Second, as pointed out in the June 29 Amendment, it would not have been obvious to one of ordinary skill in the art to size the Langley eye patch to fit within the human eye socket, because doing so would be contrary to Langley's teachings. The Langley eye patch is intended to protect a wearer's eye "during a post-surgery period or after injury to the eye" (col.

1, lines 14-15). If the eye patch were sized to fit inside the eye socket, it would be difficult or impossible to apply the eye patch without putting some pressure, or risking putting some pressure, on the sensitive eye, which clearly would be undesirable for an eye that has been injured and/or surgically operated upon. Additionally, if the eye patch were sized to fit inside the eye socket, it could not properly be held in place by tape (shown in phantom in Fig. 1) or by an elastic headband encircling the patient's head (see col. 3, lines 3-5) as taught by Langley.

Third, even if the proposed combination were made, the result would not be a "laser-resistant eye patch." To better emphasize this feature of claim 24, which is recited in the preamble, claim 24 is amended to recite that the metallic layer protects an eye from laser light. In contrast, the Langley eye patch, even if modified as suggested by the Office Action, would not protect an eye from laser light, because it has pores 16 in the eye patch. These pores 16 are for providing air flow, and would also admit light (see column 3, lines 32-36). Therefore, the "metallic layer" of the Langley eye patch clearly would not protect an eye from laser light.

Accordingly, claim 24 is patentably distinct from the applied prior art.

Krupnick and Rosenblatt do not overcome the above-noted deficiencies of Langley and Loos with respect to claim 24. Therefore, the remaining claims are patentable at least for their dependence on an allowable base claim.

B. Additionally, regarding dependent claim 45, it clearly would not have been obvious to protect a patient's eye "during treatment of an adjacent portion of the patient's face," for at least the reason that the only use of the Langley eye patch contemplated relative to any "treatment" is in the context of protecting the eye after (not "during") treatment.

For this additional reason, the rejection of dependent claim 45 is in error.

C. Additionally, the various dependent claims reciting specific thicknesses or ranges of thickness of the sheet member or metallic layer have not been adequately addressed by the Office Action. The Office Action rejects these claims simply on the basis that "the dimensions recited in the claims are not critical."

The MPEP explains that a showing of criticality, or unexpected results, "can rebut a *prima facie* case of obviousness based on overlapping ranges" (MPEP §2144.05, emphasis added). In other words, when the prior art discloses a range that overlaps the claimed range, then the applicant must show the criticality of the claimed range in order to rebut the *prima facie* case of obviousness established by that disclosure in the prior art.

In this case, however, the prior art does not even discuss thicknesses. Thus, a *prima facie* case of obviousness, e.g., evidence of overlapping ranges, has not even been established. It is improper to require a showing of criticality in such a situation.

For this additional reason, the rejection of the dependent claims reciting specific thicknesses is improper.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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